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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,927	01/24/2001	John Russell	OR00-11201	5476

51067 7590 01/25/2006

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EXAMINER

BLACKWELL, JAMES H

ART UNIT PAPER NUMBER

2176

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/769,927	<b>Applicant(s)</b> RUSSELL, JOHN	
	<b>Examiner</b> James H. Blackwell	<b>Art Unit</b> 2176	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office Action is in response to amendment received 11/04/2005 with an original priority date of **01/24/2001**.
2. Claims 1-21 are pending, Claims 1, 14-15, and 17 are independent.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-15 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Primis (Primis Custom Publishing, web pages describing product and features, dated circa 1998, Pages 1-12).

**In regard to independent Claim 1 (and similarly independent Claims 14-15 and 17),** Primis teaches *a method of composing a virtual book from a set of electronically stored documentation comprising multiple books* in that it allows a user (e.g., teacher, instructor, professor) to create custom publications online (*virtual*) using a custom publishing database that contains a collection of modular, stand-alone text files that can be mixed and matched and then seamlessly *arranged* to create a book "on demand" for a particular course (Pgs. 1-12).

Primis also teaches *identifying a plurality of topics based on the chapter and section headings in the documentation, wherein each said topic is associated with a*

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*portion of the documentation* (see Pgs. 6-12 showing publications listed by title, section (Pg. 6 first and third bullets); Pg. 7 shows details of 1<sup>st</sup> bullet of Pg. 6 chapter and section headings in document).

Primis also teaches *determining a structure of the documentation, wherein said structure indicates a hierarchy of said topics within the documentation* (see Pg. 9 shows a view of a hierarchy of said topics that the user can choose to view or add to their customized textbook from a given document source Hilton).

Primis also teaches *classifying each of said topics within one or more categories* (Pg. 9 provides the opportunity for the author to reorder the content of the customized textbook, see option for *Resequence* in upper right-hand corner of page).

Primis also teaches *receiving a subject for a virtual book* (Pg. 4).

Primis also teaches *composing said virtual book to include a subset of said topics that are relevant to said subject, and each said relevant topic includes a pointer to said associated portion of the documentation* (Pg. 9 show options to add topics to the customized textbook by clicking Add to specific topics and subtopics within the Hilton text). The user can add or view content by clicking on links associated with topics in the various publications available, Pg. 9 depicting one such example document).

Primis strongly implies that *the complete virtual book can be stored for future access* in that, once a professor or teacher gets the customized textbook into a form ready for publication, a student would have needed options to either buy a printed version at a bookstore, buy it online and download it, or buy a password to view it online. In each of these and other instances, it would have been obvious to one of

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ordinary skill in the art at the time of invention that the completed customized textbook *would have been stored*, and specifically *stored for future use* as evidenced by offering it to students for a variety of purchase and viewing options as suggested by Primis.

**In regard to dependent Claim 2, Primis teaches *searching said topics for a set of topics relevant to said subject* (Pg. 7 user can scroll the web page (*search*) the holdings that are available within the subject previously chosen).**

**In regard to dependent Claim 3, Primis teaches that *said relevant topics are grouped in said virtual book by said categories* (see Pg. 9 proposed customized textbook would show a layout (perhaps default) where topics are grouped by categories; e.g. Introduction to Law (Chapter 1) (category), topic Business Decision: Calling all Smokers (topic) and where the designer of the customized textbook would click Add to add topics perhaps sequentially as listed in the particular reference and by sequence of references chosen).**

**In regard to dependent Claim 4, Primis fails to explicitly teach that *said relevant topics within a first category are listed in the order of their relevance to said subject*. However, Primis does allow the creator of the customized textbook to restructure the layout of the final textbook (see Pg. 9, graphic upper right options to review and resequence the content) and thus would have allowed the creator to structure the topics by relevance to the subject, or by other desired means capable with such an interface. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to restructure the layout of the customized textbook to order the topics to be**

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listed by their relevance to the subject providing the reader of the customized textbook a natural flow of ideas.

**In regard to dependent Claim 5,** Primis teaches that *said relevant topics within a first category are listed in the order they occur within the documentation* (refer to the rejection of Claims 3-4 above, the creator using the interface of Pg. 9 can alter the topics to be ordered in any way available or desired).

**In regard to dependent Claim 6 (and similarly dependent Claim 19) and 7,** Primis fails to explicitly teach *identifying index entries in the documentation* and *said index entries are included in said virtual book*. However, it would have been obvious to one of ordinary skill in the art at the time of invention to identify topics for an index and to incorporate the index into the final customized textbook as these functions were typically performed with respect to most publications produced, regardless of how they are produced as a means to allow a user of the customized textbook to locate topics of interest without having to manually search the entire content of the book for those topics.

**In regard to dependent Claim 8,** refer to the rejections of Claims 4 and 5, where *sorting said relevant topics according to their relevance to said topic* would have been taught by Primis along the lines of the arguments presented in those rejections.

**In regard to dependent Claim 9 (and similarly dependent Claim 21),** Primis teaches that *said categories include one or more of the set of: concept, task, example, reference and troubleshooting* (see Pgs. 6-12 for examples of categories relating concepts, examples, and other category types).

**In regard to dependent Claim 10 (and similarly dependent Claim 20), Primis** teaches *identifying a characteristic of a viewer of said virtual book; and customizing said virtual book for the viewer on the basis of said characteristic* in that a primary intention of Primis is to offer customized publishing for the purpose of producing course materials for students taking a particular course (Pgs. 1-3). Typically, courses are limited to a particular subject matter and topics within that subject matter are taught to students with a particular interest or need in the course being offered and taught. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to realize that an instructor would have used Primis to design and produce a customized textbook, keeping in mind the subject matter and interests of the students desiring or needing to use the course materials.

**In regard to dependent Claim 11, Primis** teaches that *said characteristic is a level of experience* since a core feature of the Primis system is to allow an instructor to design and publish a customized textbook. The content of such a textbook would necessarily have been catered to the course being taught; whether the course was introductory or advanced. Thus, the characteristic of *a level of experience* would have had to be taken under consideration to provide course materials appropriate to the course level.

**In regard to dependent Claim 12, Primis** teaches that *said characteristic comprises a level of experience of the user and said customizing comprises omitting one or more of said categories from said virtual book* since a core feature of the Primis system is to allow an instructor to design and publish a customized textbook. The

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content of such a textbook would necessarily have been catered to the course being taught; whether the course was introductory or advanced. Thus, the characteristic of a *level of experience* would have had to be taken under consideration to provide course materials appropriate to the course level, and thus excluding content that was not appropriate for the experience level of the student taking the course.

**In regard to dependent Claim 13**, refer to the rejections of Claims 11 and 12, where an *employment role* would imply a certain level of experience whether, for example, and employee was a new hire or a manager. Using Primis, the instructor of a course could have created a customized textbook, and in fact, different customized textbooks based on an *employment role* of a potential student.

**In regard to dependent Claim 18**, Primis teaches a *network server configured to present said virtual book to a user* in that the customized textbooks are made available from a web site (Pgs. 6-12 show screen dumps of the customized content producing process via a web browser connected to the online Primis Custom Publishing site).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that the prior arts of Krulwich, Vaithyanathan and Husick fail to teach the limitations either alone or in combination. The Examiner respectfully agrees and withdraws the rejection. However, the Examiner now directs the Applicant to the prior art of Primis, which teaches the claimed limitations. Primis teaches a web site that allows an instructor to create



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customized instruction materials for a class based on a database of titles, or their own material, or a combination thereof.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

7. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell  
01/17/2006

*William L. Bashore*  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**  
*1/20/2006*